

OCT 31 2005

60469-037
OT-4812

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: O'Donnell, et al.
Serial No.: 09/921,803
Filed: 08/03/2001
Group Art Unit: 3652
Examiner: Tran, Thuy Van
For: ELEVATOR BELT ASSEMBLY WITH WAXLESS COATING

Commissioner For Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE

Dear Sir:

This is response to the Office Action mailed on August 23, 2005. Applicant respectfully requests reconsideration of this application.

There is no *prima facie* case of obviousness against any of Applicant's claims. The German Patent No. 3934654 discloses a "plastic" belt body with exposed strands at the ends of the belt for establishing electrical connections between the strands.

The *Scudder* reference teaches a method of forming polyurethane coatings that includes interacting with an uncured polyurethane using a moving surface. The *Scudder* reference includes applying "liberally, a lubricating barrier in the form of a layer of oily substance, or a thick film, over the layer of polyurethane prior to its being engaged by the second moving surface." (Column 1, line 41-44).

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There is no motivation for making the proposed combination of the German patent and the *Scudder* reference. The polyurethane forming technique of the *Scudder* reference provides no benefit whatsoever in the German patent. That technique will not in any way enhance the ability to make the electrical connections taught in the German reference.

Without any benefit for making the combination, there is no motivation for making it. In other words, the proposed combination cannot be made and there is no *prima facie* case of obviousness.

Even if the combination could somehow be made, neither reference teaches a waxless polyurethane. To the extent that the Examiner is relying upon the teachings of *Scudder* regarding the "sticky" polyurethane in the *Scudder* reference, that is referring to the material before it is fully cured when the material has not yet hardened. That is not a teaching of a polyurethane without wax. Therefore, even if the improper combination were made, the result would not be the same as Applicant's claimed invention.


This application is in condition for allowance.

Applicant notes that the Examiner has not provided a complete translation of the German patent relied upon in the most recent office action. Applicant has obtained a complete translation of that document and encloses a copy so that the record is complete regarding this application. When a foreign document is being relied upon, a complete translation of that document should be provided by the Examiner so that an Applicant can

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make a full assessment of the teachings of that reference. See, e.g., *Ex parte Gavin*, 62 USPQ 2d 1680 (2001).

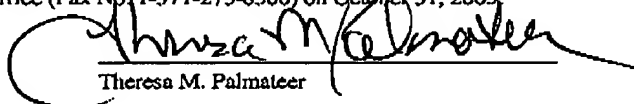
Respectfully submitted,
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Dated: October 31, 2005

CERTIFICATE OF FACSIMILE

I hereby certify that this Response, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. 1-571-273-8300) on October 31, 2005.


Theresa M. Palmateer

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